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In re Application of ZHOU et al.
Application No.: 10/521,973
PCT No.: PCT/CA03/01189
Int. Filing: 08 August 2003
Priority Date: 16 August 2002
Attorney Docket No.: 102699-102
For: PHOSPHONIUM AND IMIDAZOLIUM
SALTS AND METHODS OF THEIR
PREPARATION

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 15 September 2005, to accept the application without the signature of joint inventor, Yuehui Zhou.

BACKGROUND

On 21 January 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 11 July 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 16 September 2005, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Yuehui Zhou. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Yuehui Zhou alleging that Mr. Zhou cannot be found or reached to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition did not include the requisite \$200 petition fee. However, authorization to charge applicant's deposit account for any additional fees was provided with the PTO-1390 and the petition fee was charged to that deposit account, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor, Yuehui Zhou, was provided. With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventor was submitted and satisfies the requirements of 37 CFR 1.47(a).

With respect to Item (2) above, Petitioner provided a statement of facts in the petition under 37 CFR 1.47(a). Counsel states that various attempts, via mail, telephone and email, were made by others to contact Mr. Zhou. These attempts proved unsuccessful and counsel concludes that Mr. Zhou cannot be reached or located.

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a *person having firsthand knowledge* of the facts recited therein. *Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.* The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions. See MPEP 409.03(d).

The facts relied upon in the instant case appear to have occurred between 17 November and 20 December 2004. An attempt by counsel to contact the nonsigning inventor occurred on 09 September 2005. Petitioner did not provide a first hand statement from the person having firsthand knowledge of the facts recited therein. Moreover, it is unclear whether Mr. Zhou was temporarily unavailable or is no longer available at his last known address to sign the application papers. Petitioner has not provided any evidence of further attempts made to obtain Mr. Zhou's current address, telephone number or email address by contacting his last employer or co-inventors or through a search of the Internet to locate him¹. Petitioner should submit evidence of his diligent efforts to locate or reach the non-signing inventor before it can be concluded that Mr. Zhou cannot be reached or located.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a *copy of the application papers for U.S. application 10/521,973 (specification, including claims, drawings, and declaration)* to the nonsigning inventor for his signature or (2) the attempts to locate or reach Mr. Zhou despite diligent efforts.

For the reasons set forth above, the evidence submitted does not support a finding that the

¹Applicant is reminded that he must provide proof of the attempts to deliver a complete copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor.

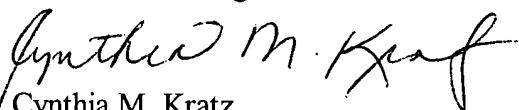
nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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